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Christopher M. Goff (27839)			FIDEI, DAVID	
ARMSTRONG TEASDALE LLP				
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BETH A. LANGE

Appeal 2009-005918
Application 10/741,678
Technology Center 3700

Before JENNIFER D. BAHR, STEFAN STAICOVICI, and FRED A. SILVERBERG, *Administrative Patent Judges*.

BAHR, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

Beth A. Lange (Appellant) filed a “REQUEST FOR REHEARING UNDER 37 C.F.R. §41.52” dated June 25, 2010, (hereinafter “Request”) of our decision dated April 27, 2010 (hereinafter “Decision”). In that Decision, we affirmed the rejection of claims 15, 23, 28, and 29 under 35 U.S.C. § 103(a) as being unpatentable over Ehrlich (US 4,221,221, issued Sep. 9, 1980) and Gallo (US 6,622,856 B2, issued Sep. 23, 2003).

Appellant alleges that in reaching our Decision, we misapprehended the disclosure of Ehrlich. Request 1. Specifically, Appellant argues that the statement that “Ehrlich explicitly contemplates inclusion of other baby maintenance items in addition to or in place of the specifically illustrated powder, oil, and towel containers” (Decision 3, Fact 2) is in error. Request 1.

According to Appellant, the fact that “Ehrlich discloses using more than three container assemblies adhered to a diaper does not necessarily mean that the container assemblies would contain anything but powder, oil, or a towel.” *Id.* Appellant reasons that Ehrlich’s reference to the powder, oil, and towel as being “the ‘major elements’ of the container assemblies” conveys that the powder, oil, and towel are “the most important components of the container assemblies.” Request 2. Thus, Appellant argues, one of ordinary skill in the art would not “replace one of the ‘major elements’ of the container assemblies with something completely unrelated to changing a diaper.” *Id.*

Appellant’s argument does not convince us that we erred in finding that “Ehrlich explicitly contemplates inclusion of other baby maintenance items in addition to or in place of the specifically illustrated powder, oil, and towel containers.” Ehrlich’s reference to the powder, oil, and towel as

“major elements” (col. 3, ll. 20-21) in fact suggests the inclusion of other items of lesser importance or rank², i.e., “ancillary”³ products such as sunscreen. *See* Gallo, col. 5, ll. 20 and 26 (describing products such as sunscreen as “ancillary products” to the kit).

Appellant’s Request also argues that the Board’s rationale in opining that “a person of ordinary skill in the art would have appreciated that it would have been advantageous to include sunscreen, a well-known accessory for the care/protection of babies for outdoor activities, on the utility diaper of Ehrlich, so that the sunscreen would be available when needed” (Decision 5) is “overly broad and overly inclusive.” Request 2-3. Appellant argues that “at best, it would have been obvious to attach only the products listed by Gallo that are related to changing a diaper (e.g., petroleum jelly, powder, baby oil) to the diaper of Ehrlich.” Request 3. As noted on page 4 of our Decision, Appellant’s position fails to appreciate the full scope of Ehrlich’s teachings, which are directed to “baby maintenance” items (col. 1, ll. 44-47, *see* Decision 3, Fact 1) that is, items used in caring for babies, not simply diaper changing products.

Moreover, as pointed out on page 6 of our Decision, the Supreme Court has stated that a rigid insistence on teaching, suggestion, or motivation is incompatible with its precedent concerning obviousness. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). A conclusion of obviousness must

² *See Webster’s New World Dictionary* 854 (David B. Guralnik ed., 2nd Coll. Ed., Simon & Schuster, Inc. 1984) (defining “major” as “greater in importance or rank”).

³ *See Webster’s* at 51 (defining “ancillary” as “subordinate”) and *id.* at 1419 (defining “subordinate” as “inferior to or placed below another in rank, power, importance, etc.”).

be supported by explicit findings and analysis establishing an apparent reason to combine the known elements in the manner required in the claim at issue. *Id.* However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* As we pointed out on page 5 of our Decision, the modification proposed in the affirmed rejection is nothing more than the predictable use of prior art elements according to their established functions. *See id.* at 417 (an improvement that is nothing more than the predictable use of prior art elements according to their established functions is likely to be obvious).

CONCLUSION

The arguments in Appellant’s Request have not convinced us that we erred in affirming the rejection of claims 15, 23, 28, and 29 under 35 U.S.C. § 103(a) as being unpatentable over Ehrlich and Gallo.

DECISION

Appellant’s Request has been granted to the extent that we have reconsidered our Decision in light of the arguments in Appellant’s Request, but is denied with respect to our making any modification to the Decision.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

DENIED

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Christopher M. Goff (27839)
ARMSTRONG TEASDALE, LLP
7700 Forsyth Boulevard
Suite 1800
St. Louis, MO 63105